

REMARKS

In response to the final Office Action mailed May 10, 2004 (Paper No. 11), the Assignee submits the following remarks. The Office Action rejected Claims 1-40 as obvious in view of various combinations of the following cited art: U.S. Patent Application Publication No. US 2001/0011245 A1 to *Duhon* (hereinafter "*Duhon*"); "New Privista Product Provides Early Warning System to Combat Identity Theft ID Guard to Build Consumer Confidence, Save Companies Lost Revenue," October 23, 2000 (hereinafter "*Warning System*"); U.S. Patent Application Publication No. US 2002/0133462 A1 to *Shetyn* (hereinafter "*Shetyn*"); "About ID Guard," January 24, 2001 (hereinafter "*About ID Guard*"); "PrivacyGuard.com," December 11, 2000 (hereinafter "*Privacy Guard.com*"); "Soups Up ID Theft Monitoring Service," January 26, 2001 (hereinafter "*Soups Up ID Theft Monitoring Service*"); CreditCheck Monitoring Service, December 11, 2000 (hereinafter "*Credit Check*"); and U.S. Patent Application Publication No. US2002/0194143 to *Banerjee et al.* (hereinafter "*Banerjee*").

The present response traverses all of the Office Action rejections. The pending claims include elements that are neither taught or suggested by the cited art, and the cited art is distinguished for at least the following reasons:

- *Shetyn* relates to electronic notification of a credit card holder and does not disclose how its notification would work with a credit reporting database, therefore there is no reasonable expectation of success in combining the teaching of *Shetyn* with any combination of the teachings of *Duhon*, *Warning System*, *About ID Guard*, *PrivacyGuard.com*, *Soups Up ID Theft Monitoring Service*, *Credit Check*, and *Banerjee*.

- The claimed invention sends a notification to the user substantially contemporaneously with when a modification to a credit reporting database occurs;
- The claimed invention notifies a customer substantially contemporaneously with when a change occurs to data in a credit reporting database;
- The claimed invention provides a credit modification monitoring service that permits selecting a method of notification comprising communication substantially contemporaneous with when a modification to a credit reporting database occurs;
- The claimed invention permits a user to provide a warning about an element in the credit reporting database; and
- The claimed invention provides a credit modification monitoring service wherein a subscription price depends on a frequency of a selected notification to a credit reporting database.

These and other arguments are presented in the remarks below.

I. THE REJECTION OF CLAIMS 1, 3-6, 10-12, 14, AND 18 (OFFICE ACTION, ¶ 5)

The Office Action rejected Claims 1-6, 9-12, 14-16, 18, and 35-37 under 35 U.S.C. § 103(a) as unpatentable over *Duhon* in view of *Warning System* and further in view of *Shetyn*. Office Action, pp. 2-8, ¶ 5. Previously amended independent claims 1, 5, and 12 relate to notifying a user when a change or modification to a credit reporting database occurs. Notification of a user substantially contemporaneously with when a change occurs in the user's credit file permits the user to take early action for a variety of reasons such as correcting a credit report, or preventing identity theft. See ¶¶ 15-16.

For at least claim 1, the Office Action admits that *Duhon* does not explicitly teach “wherein the monitoring module monitors the modifications to at least one element selected by the user and sending a notification to the user,” and further admits that neither *Duhon* nor *Warning System* teach the element of “substantially contemporaneously.” Office Action, p. 3, lines 13-21. A *prima facie* rejection of obviousness under 35 U.S.C. §103(a) requires a reasonable expectation of success in modifying or combining the prior art. *In re Merck*, 800 F.2d 1091 (Fed. Cir. 1986). *Shetyn* relates to notifying a credit card holder regarding unauthorized credit card transactions, and it is not clear from *Shetyn* or any other cited reference how the teaching of *Shetyn* could be modified or combined with the other cited references to operate with a credit reporting database. Even though *Shetyn* states that “a credit history-reporting agency can notify the user when a new record is entered or a request for credit verification is submitted,” *Shetyn* and the other cited references do not disclose or suggest how to apply its teachings to a “credit history-reporting agency” or to a credit reporting database as in the claimed Applicants’ invention. The server 106 disclosed by *Shetyn* handles credit card numbers and transactions, which is an altogether different structure having different functionality than a credit reporting database. There can be no degree of predictability in combining *Shetyn* with the other cited references to obtain any element of the claimed invention, since *Shetyn* relates to notifying a credit card holder regarding unauthorized credit card transactions, and since *Shetyn* does not disclose any “detailed enabling methodology” for any structural element or functionality associated with a “credit history-reporting agency” or with a credit reporting database. See *In re O’Ferrell*, 853 F.2d 894, 903 (holding that a claimed method would have been obvious over the prior art relied upon because one reference contained

detailed enabling methodology). Therefore, there is no reasonable expectation of success to combine the teachings of *Shetyn* with either of *Duhon* or *Warning System*, and the Office Action fails to make a *prima facie* showing of obviousness.

Furthermore, a *prima facie* rejection of obviousness under 35 U.S.C. §103(a) requires that all claim limitations be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). The Office Action admits that *Duhon* does not teach or suggest the element “wherein the monitoring module monitors the modifications to at least one element selected by the user and sending a notification to the user,” and further admits that neither *Duhon* nor *Warning System* teach the element of “substantially contemporaneously.” *Shetyn* cannot be relied upon to teach or suggest the element of “substantially contemporaneously” with respect to a credit reporting database, for at least the reason provided above. Therefore, not all of the claim elements are disclosed or suggested by the cited references, and the Office Action fails to make a *prima facie* case of obviousness.

The remaining independent claims 5 and 12 also rely on similar arguments for patentability as advanced above. Moreover, dependent Claims 2-4, 6, 9-11, 14-16, 18, and 35-37 are ultimately dependent from at least one of the independent claims 1, 5, or 12, for which arguments of patentability have already been advanced above.

II. THE REJECTION OF CLAIMS 19, 20, AND 38 (OFFICE ACTION, ¶ 6)

The Office Action rejected Claims 19, 20, and 38 under 35 U.S.C. § 103(a) as unpatentable over *Warning System* in view of *Duhon* and further in view of *Shetyn*. Office Action, pp. 8-9, ¶ 6. The Office Action fails to make a *prima facie* case of obviousness for

rejecting these claims for at least the same reasons as advanced above. Therefore these claims should also be patentable over the cited art.

III. THE REJECTION OF CLAIMS 7 AND 13 (OFFICE ACTION, ¶ 7)

The Office Action rejected Claims 19, 20, and 38 under 35 U.S.C. § 103(a) as unpatentable over *Duhon* in view of *Warning System* in view of *Shetyn* and further in view of *About ID Guard*. The Office Action fails to make a prima facie case of obviousness for rejecting these claims for at least the same reasons as advanced above. Therefore these claims should also be patentable over the cited art.

IV. THE REJECTION OF CLAIM 8 (OFFICE ACTION, ¶ 8)

The Office Action rejected Claim 8 under 35 U.S.C. § 103(a) as unpatentable over *Duhon* in view of *Warning System* in view of *Shetyn* further in view of *About ID Guard* and in further view of *PrivacyGuard.com*. The Office Action fails to make a prima facie case of obviousness for rejecting these claims for at least the same reasons as advanced above. Therefore these claims should also be patentable over the cited art.

V. THE REJECTION OF CLAIM 17 (OFFICE ACTION, ¶ 9)

The Office Action rejected Claim 17 under 35 U.S.C. § 103(a) as unpatentable over *Duhon* in view of *Warning System* in view of *Shetyn* and further in view of *Soups Up ID Theft Monitoring Service*. The Office Action fails to make a prima facie case of obviousness for rejecting these claims for at least the same reasons as advanced above. Therefore these claims should also be patentable over the cited art.

VI. THE REJECTION OF CLAIM 21 (OFFICE ACTION, ¶ 10)

The Office Action rejected Claim 21 under 35 U.S.C. § 103(a) as unpatentable over *Warning System* in view of *Duhon* further in view of *Shetyn* and further in view of *PrivacyGuard.com*. The Office Action fails to make a prima facie case of obviousness for rejecting these claims for at least the same reasons as advanced above. Therefore these claims should also be patentable over the cited art.

VII. THE REJECTION OF CLAIMS 26-34 (OFFICE ACTION, ¶ 11)

The Office Action rejected Claims 26-34 under 35 U.S.C. § 103(a) as unpatentable over *Warning System* in view of *Credit Check* and further in view of *Shetyn*. The Office Action fails to make a prima facie case of obviousness for rejecting these claims for at least the same reasons as advanced above. Therefore these claims should also be patentable over the cited art.

VIII. THE REJECTION OF CLAIMS 22-24, AND 39 (OFFICE ACTION, ¶ 12)

The Office Action rejected Claims 22-24, and 39 under 35 U.S.C. § 103(a) as unpatentable over *Warning System* in view of *Duhon* and further in view of *Shetyn*. The Office Action fails to make a prima facie case of obviousness for rejecting these claims for at least the same reasons as advanced above. Therefore these claims should also be patentable over the cited art.

IX. THE REJECTION OF CLAIM 25 (OFFICE ACTION, ¶ 13)

The Office Action rejected Claim 25 under 35 U.S.C. § 103(a) as unpatentable over *Warning System* in view of *About ID Guard* further in view of *Duhon* further in view of *Shetyn* and further in view of *PrivacyGuard.com*. The Office Action fails to make a prima facie case of obviousness for rejecting these claims for at least the same reasons as advanced above. Therefore these claims should also be patentable over the cited art.

X. THE REJECTION OF CLAIM 40 (OFFICE ACTION, ¶ 14)

The Office Action rejected Claim 40 under 35 U.S.C. § 103(a) as unpatentable over *Warning System* in view of *Credit Check* further in view of *Shetyn* further in view of *Banerjee*. The Office Action fails to make a prima facie case of obviousness for rejecting these claims for at least the same reasons as advanced above. Therefore these claims should also be patentable over the cited art.

CONCLUSION

Claims 1-40 are pending in the application. Independent Claims 1, 5, 12, 19, 22, and 26 have been amended. Claims 1-40 are now in condition for allowance. The Examiner is invited and encouraged to contact the undersigned attorney of record at (404) 815-6048 if such contact will facilitate a Notice of Allowance for Claims 1-40. If any additional fees are due, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 11-0855.

Respectfully submitted,



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